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PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

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OFFICE OF PETITIONS

In re Patent No. 7,484,688 :
Chow et al. : DECISION ON
Application No. 10/533,376 : REQUEST FOR
Issue Date: February 3, 2009 : RECONSIDERATION OF
Filed: April 29, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. : UNDER 37 CFR 1.705
2733.30US01 :

This is in response to the PETITION UNDER 37 C.F.R. § 1.705(d), filed on April 3, 2009. Patentee requests that the determination of patent term adjustment be corrected from six hundred forty-two (642) days to nine hundred eighteen (918) days.

The request for reconsideration of patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of six hundred thirty-nine (639) days.

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

BACKGROUND

This application fulfilled the requirements of 35 U.S.C. 371 on May 2, 2005.¹ On September 25, 2008, the Office mailed a notice

¹The priority date in this application is November 1, 2002. Applicants did not file an express request under 35 U.S.C 371(f). Accordingly, the date which is 30 months from the priority date is May 1, 2005. As May 1, 2005 fell on a Sunday, the commencement date is shifted to May 2, 2005. See PCT

that the initial determination of patent term adjustment under 35 U.S.C. 154(b) to date is 642 days². On February 3, 2009, the application matured into U.S. Patent No. 7,484,688, with a revised patent term adjustment of 642 days. The Office determined that the 277 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)^{3,4} overlaps with the 642 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1)⁵ accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 642 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of no days, the patent issued with a revised patent term adjustment of 642 days.

Rule 80.5. Additionally, as applicant completed all 35 U.S.C. 371 requirements on filing the national stage prior to commencement, the completion date is also shifted to May 2, 2005.

² 642 days of Office delay was reduced by 0 days of applicant delay for a patent term adjustment of 642 days. No request for reconsideration of this initial determination was filed.

³ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

⁴ As of the issuance of the patent on February 3, 2009, the application was pending three years and 277 days.

⁵ 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

On April 3, 2009, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 918 days under the courts interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 918 (640 + 278) days as these periods do not occur on the same day.

Patentee further avers that the Office has miscalculated the date of completion of all 371 requirements as April 29, 2005, rather than May 1, 2005. Accordingly, patentee states the period of Office delay under §154(b)(1)(A) & (B) begins on May 1, 2005, rather than April 29, 2005.

OPINION

35 U.S.C. 371(b) states that subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

Article 39(1) states that

(a) if the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.

(b) Any national law may, for performing the acts referred to in subparagraph (a), fix time limits which expire later than the time limit provided for in that subparagraph.

PCT Rule 80.5 states that if the expiration of any period during which any document or fee must reach a national

Office or intergovernmental organization falls on a day:

(i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;

(ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;

(iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or

(iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; the period shall expire on the next subsequent day on which none of the said four circumstances exists.

Patentee is correct that the completion date and commencement date under 35 U.S.C. § 371 were miscalculated. The priority date in this application is November 1, 2002. Applicants did not file an express request under 35 U.S.C. 371(f). As the date which is 30 months from the priority date, May 1, 2005, fell on a Sunday, the commencement date is shifted to May 2, 2005. See PCT Rule 80.5. Additionally, as applicant completed all 35 U.S.C. 371 requirements on filing the national stage prior to commencement, the completion date is also shifted to May 2, 2005. Accordingly, the date of fulfillment of the requirements of § 371, and the date of commencement in the national stage, is May 2, 2005.

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A).

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁶ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz.

⁶ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C.

154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date of fulfillment of the requirements of 35 U.S.C. 371, May 2, 2005, and ending on the date of the issuance of the application as a patent, February 3, 2009 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 639 days of patent term adjustment should have been accorded during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 277 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the date of fulfillment of the requirements of 35 U.S.C. 371.

All of the 277 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 639 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 639 days and the 277 days is neither permitted nor warranted. The actual number of days issuance of the patent was delayed is 639 days.

Accordingly, at issuance, the Office should have entered 639 days of patent term adjustment.

CONCLUSION

In view thereof, the revised determination of patent term adjustment at the time of the issuance of the patent is 639 days.

The Office thanks Patentee for their good faith and candor in bringing this matter to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred thirty-nine **(639)** days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.



Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

Encl: DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,484,688 B2

DATED : February 3, 2009

INVENTOR(S) : Chow et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (642) days

Delete the phrase "by 642 days" and insert – by 639 days--